

REMARKS

Applicant has thoroughly considered the Examiner's remarks and claims 1-25 and 27-40 are now presented in this application for further examination. Claims 1, 18, 24 and 38 have been amended by this Amendment D to more clearly set forth the invention. Reconsideration of the application in view of the following remarks is respectfully requested.

Claim Rejections under 35 U.S.C. § 112

Claims 1-25 and 27-40 stand rejected under 35 USC §112 as failing to comply with the written description requirement. According to the Office, the present application "does not provide support for said projected light beam (projected light beam A) is reflected from a reference surface acting as a field stop for limiting direct detection of light reflected from the tracking surface prior to said detecting" as claimed."¹ Applicant has thoroughly considered the rejection and respectfully disagrees.

Applicant notes that "adequate description under the first paragraph of 35 U.S.C. § 112 does not require **literal** (i.e., using the same terms or in *haec verba*) support for the claimed invention Rather, it is sufficient if the originally-filed disclosure would have conveyed to one having ordinary skill in the art that an [applicant] had possession of the concept of what is claimed."² The present application provides sufficient disclosure to satisfy this requirement.

Claim 1

Claim 1, as amended, recites an input device for use with a tracking surface including:

a single laser having a cavity from which **a light beam is projected**, said laser being configured to **project the light beam onto said tracking surface**, at least a **portion of the light beam striking said tracking surface reflecting back** into the cavity of said laser, said **light beam being subsequently projected** and thereby altering at least one characteristic of the **light beam projected by the laser**, wherein said **subsequently projected light beam** is reflected from a reference surface acting as a field stop for limiting direct detection of light reflected from the tracking surface prior to said detecting;

a detector associated with the laser for detecting said altered characteristic of the **light beam projected by the laser**; and

¹ June 28, 2007 Office action, pages 2-3.

² *Ex parte Parks*, 30 USPQ2d 1234 (B.P.A.I 1994) (emphasis in original); see MPEP §2163.02.

a controller responsive to the detector for determining the relative distance between said device and said tracking surface as a function of the altered characteristic of the **subsequently projected light beam** detected by the detector.

The amendments are supported in the present application in FIG. 3 and on page 6, paragraph 22. For example, the device generally comprises a single laser for projecting a laser light beam A (**projected light beam or beam projected by the laser**) onto the tracking surface. A portion of the light beam A striking the tracking surface reflects back as light beam B (**reflected light beam**) into a cavity of the laser and thereby alters at least one characteristic of the subsequently projected light beam C (**subsequently projected light beam**). The mixing of laser light B backscattered (i.e., reflected back) from the tracking surface and into the cavity of the laser will alter the output of light beam C of the laser. And, by detecting even small alterations in the output C of the laser, the movement of the tracking surface relative to the laser cavity, and in turn the device itself, may be understood.

In light of the foregoing, Applicant submits that the originally-filed disclosure conveys to one having ordinary skill in the art that Applicant possessed the concept of claim 1. Moreover, the cited art fails to teach or suggest each and every aspect of the claimed invention, including a "subsequently projected light beam being reflected from a reference surface acting as a field stop for limiting direct detection of light reflected from the tracking surface prior to said detecting." Therefore, claim 1 is believed to be allowable. Claims 2-17 depend from claim 1 and are believed to be allowable for at least the same reasons.

Claims 18, 24 and 38 have been similarly amended as claim 1 and are allowable for at least the same reasons as claim 1. Claims 19-23, 25, 27-37, 39 and 40 depend from claims 18, 24 and 38, respectively, and are believed to be allowable for at least the same reasons.

In view of the amendments and remarks above, Applicant request that the Office withdraw the rejection under 35 U.S.C. §112, first paragraph and allow claims 1-25, and 27-40. Should the Examiner maintain the rejections of these claims on these grounds in the next Office action, Applicant request that the Examiner provide detailed evidence or reasons why persons skilled in the art would not recognize in the disclosure a description of the invention defined by these claims.

Claims 1-25 and 27-40 stand rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which

applicant regards as the invention. The Examiner asserts on page 3 of the Office action that claims 1, 18, 24, and 38 are confusing as to "said projected light beam". As explained above, Applicants have amended the claims to more clearly set forth the subject matter. For example, claim 1, as amended, recites "a single laser having a cavity from which a light beam is projected, said laser being configured to project the light beam onto said tracking surface, at least a portion of the light beam striking said tracking surface reflecting back into the cavity of said laser, **said light beam being subsequently projected** and thereby altering at least one characteristic of the light beam projected by the laser, wherein said **subsequently projected light beam** is reflected from a reference surface acting as a field stop for limiting direct detection of light reflected from the tracking surface prior to said detecting." Therefore, claim 1 is believed to be allowable.

Claims 2-17 depend from claim 1 and are believed to be allowable for at least the same reasons.

Claims 18, 24 and 38 have been similarly amended as claim 1 and are allowable for at least the same reasons as claim 1. Claims 19-23, 25, 27-37, 39 and 40 depend from claims 18, 24 and 38, respectively, and are believed to be allowable for at least the same reasons.

In view of the foregoing, favorable reconsideration and allowance of this application is requested.

The Applicants wish to expedite prosecution of this application. If the Examiner deems the claims not in condition for allowance, the Examiner is invited and encouraged to telephone the undersigned to discuss making an Examiner's amendment to place the claims in condition for allowance.

The Commissioner is authorized to charge Deposit Account No. 19-1345 for a one-month extension of time.

Respectfully submitted,

/Robert M. Bain/

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